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Mattias Ernst

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EXAMINER

COPPOLA, JACOB C

ART UNIT

PAPER NUMBER

3621

NOTIFICATION DATE

DELIVERY MODE

12/14/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

Office Action Summary	Application No. 10/563,230	Applicant(s) ERNST ET AL.	
	Examiner JACOB C. COPPOLA	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 and 36-38 is/are pending in the application.
- 4a) Of the above claim(s) 12-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 36-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is in reply to amendments to the claims and remarks filed on 05 August 2009 (“09 Aug Response”).
2. Claims 1-32 and 36-38 are currently pending.
3. Claims 1-11 and 36-38 have been examined.
4. Claims 12-32 were withdrawn in the Office action mailed on 05 March 2009 (see ¶ 9).
5. This Office Action is given Paper No. 20091203. This Paper No. is for reference purposes only.
6. Applicants have indicated an interest in scheduling an interview with the Examiner and can do so by emailing the Examiner at jacob.coppola@uspto.gov or by calling the Examiner directly at 571-270-3922.

Claim Rejections - 35 USC §112, Second Paragraph

7. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claims 1-11 and 36-38 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Regarding Claim 1

9. Claim 1 recites “determining a network terminating unit of the existing connection, and a calling party number of the customer and a called number of the service provider. Claim 1 is indefinite because it is unclear how the independent clause “a calling party number of the customer and a called number of the service provider” relates to the act of “determining.” For the purpose of prior art, the Examiner will interpret the independent clause “a calling party number of the customer and a called number of the service provider” to have no relation to the “determining a network terminating unit of the existing connection,” which is consistent with proper grammatical interpretations. See Strunk et al., p. 5.

Regarding Claim 2

10. Claim 2 recites “wherein the setup of the connection by the customer is...” Claim 2 depends from claim 1. Claim 1 does not recite a “setup of the connection.” Accordingly, the scope of claim 2 cannot be determined because it is unclear to what the “wherein the setup of the connection by the customer is...” is referring.

Regarding Claim 36

11. Claim 36 recites “wherein said broadcast source is an over-the-air broadcast source, transmitted by antennas.” Claim 36 is indefinite because one of ordinary skill in the art would not be able to determine *what* is “transmitted by antennas.”

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12. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, Second paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC §103

13. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-5, 8-11, and 36-38, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Hylton et al. (U.S. 5,613,191 A) ("Hylton"), in view of Downs et al. (U.S. 6,226,618 B2) ("Downs").

Regarding Claim 1

15. Hylton discloses:

receiving encrypted program content from a broadcast source (at least c. 21, l. 44-49);
connecting to a service provider by a customer via the customer's subscriber network, by placing a telephone call (c. 16, l. 6-35; and c. 17, l. 28-32);

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determining a network terminating unit of the existing connection, and a calling party number of the customer and a called number of the service provider (c. 16, l. 19-35 and l. 54-65);
transmitting a decryption code for a program content to the customer (c. 22, l. 20-37);
establishing billing data using a network terminating unit, in particular the calling party number, the called number of the service provider, and information about the requested program content (c. 15, l. 30-52).

16. Hylton does not directly disclose that the “establishing of billing data” is performed “using *the* network terminating unit” (emphasis added by the Examiner).

17. Additionally, Hilton does not directly disclose wherein said program content data is transmitted through a different medium than said decryption code.

18. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the terminating unit of Hylton the function of establishing of billing data as taught by Hylton’s HDT **1180** since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

19. Furthermore, Downs teaches:

wherein program content data is transmitted through a different medium than a corresponding decryption code (fig. 6 with associated text).

20. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the method of Hylton to include transmitting the program content

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data and decryption code through different mediums, as taught by Downs, in order to prevent fraudulent users from intercepting both content and decryption code in a single transmission.

Regarding Claims 2-5, 8-11, and 36-38

21. The combination of Hylton and Downs discloses the limitations of claim 1, as shown above, and further discloses the limitations of:

Claim 2: Method according to Claim 1, wherein the setup of the connection by the customer is executed by the dialing of a call number of the service provider and the acceptance of the telephone call by the service provider (c. 16, l. 19-35 and l. 54-65; see also c. 2, l. 30-38);

Claim 3: Method according to Claim 1, wherein at least one additional identification feature is retrieved from the caller during the period of the telephone call and before the transmission of the decryption code (c. 16, l. 54-65);

Claim 4: Method according to Claim 3, wherein the validity of the identification features is checked, and the decryption code is transmitted only in the case of validity (c. 16, l. 54-65; and c. 22, l. 20-37);

Claim 5: Method according to Claim 3, wherein the additional identification features include at least one of the following: an age-related or personal identification code, an identification or device number of a decoder receiving the decryption code (c. 16, l. 19-35; and c. 16, l. 54-65);

Claim 8: Method according to claim 1, wherein the program content for which the decryption code is to be sent is queried before the transmission of the decryption code (c. 22, l. 20-37);

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Claim 9: Method according to claim 1, wherein at least one of the following items of information is stored for the billing data, or forwarded to a corresponding billing unit: the called number, the time and/or duration of the telephone connection, the additional identification features and/or the transmitted decryption code (c. 7, l. 30-56);

Claim 10: Method according to claim 1, wherein the billing data is forwarded to the telecommunication service provider for collection (c. 7, l. 30-56);

Claim 11: Method according to claim 1, wherein the called number is a service number, which is billed via the telecommunication service provider (c. 7, l. 30-56);

Claim 36: The method according to Claim 1, wherein said broadcast source is an over-the-air broadcast source, transmitted by antennas (c. 10);

Claim 37: The method according to Claim 1, wherein said broadcast source is a line-connected transmission source (c. 5-6); and

Claim 38: The method according to Claim 1, wherein said decryption code is transmitted through a telephone line (c. 5, 6, 21, and 22).

22. Claims 6 and 7, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Hylton and Downs, in view of Applicants' Own Admission ("AOA") (see arguments below).

Regarding Claims 6 and 7

23. The combination of Hylton and Downs discloses the limitations of claims 1 and 4, as shown above.

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24. Hylton does not directly disclose:

wherein the decryption code is generated specifically for the identified decoder and transmitted to this; and

wherein the information about the identified calling party number is integrated in the decryption code.

25. However, AOA discloses that generating a decryption code based on properties of a device is old and well-known in the art because this allows for the decryption code to be used by only the device with those properties.

26. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to generate the decryption code of Hylton using the calling number of the device of Hylton in order to limit the decryption code to that device.

Response to Arguments

Prior Art

27. With respect to claim 1, Applicants arguments (pp. 12 and 13 of the 09 Aug Response) against Hylton are moot in view of the new grounds of rejection.

28. With respect to claim 2, the Examiner notes that the Background of Hylton is used only as supporting evidence of the state of the art at the time of Applicants' invention. The limitations of claim 2 are disclosed by the embodiment of Hylton articulated in the rejection above.

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29. With respect to claim 2, Applicants argue:

Hylton does not explicitly disclose a customer dialing a telephone number, as recited in claim 2. That is, according to the recited passages, a subscriber appears to initiate a session with a broadband interactive service provider, however no mention is made regarding a telephone call to the service provider, as recited in claim 2.

See 09 Aug Response, p. 14.

30. The Examiner respectfully disagrees. The subscriber is specifically referred to as the “caller” with respect to the initiated session with the provider.

Official Notice

31. Applicants’ attempt at traversing the Official Notice findings as stated in the previous Office action (Paper No. 20090217, ¶ 21w) is inadequate. Adequate traversal is a two step process. First, applicants must state their traversal on the record. Second and in accordance with 37 C.F.R. §1.111(b) which requires applicants to specifically point out the supposed errors in the Office Action, applicants must state *why* the Official Notice statements are not to be considered common knowledge or well known in the art.

32. In this application, Applicants have not met step (1) or step (2) because Applicants have failed to clearly state a traversal to the Official Notice statements and have failed to argue *why* the Official Notice statements are not to be considered common knowledge or well known in the art. Because Applicants’ traversal is inadequate, the Official Notice statements are taken to be admitted prior art. See MPEP §2144.03.

Conclusion

33. Applicants' amendment filed in the 09 Aug Response necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

34. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112, 1st paragraph written description and enablement, §112, 2nd paragraph indefiniteness, and §102 and §103, prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

35. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

36. The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure (see attached form PTO-892).

37. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

38. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Patent Examiner, Art Unit 3621
December 3, 2009

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621